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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,526	10/26/2000	Dan Vassilovski	990301	6563

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QUALCOMM INCORPORATED
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EXAMINER	
WOOD, WILLIAM H	
ART UNIT	PAPER NUMBER
2193	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	09/698,526	VASSILOVSKI ET AL.	
	Examiner	Art Unit	
	William H. Wood	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 21-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 21-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/22/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-8 and 21-24 are pending and have been examined.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 22 October 2003 was considered by the examiner as indicated on the 1449 form.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21 and 22 encompass software *per se* by reciting "means for" limitations, which based upon the specification includes software elements and no hardware elements (as all means are possibly claimed). Claims 23 and 24 encompass non-tangible "signal" media (Specification: page 4, lines 20-21), which is non-statutory.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 21 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps pertain to the relationship of the authentication flag to the updating method. Claims 23 and 24 are unclear for reciting a single instruction in line 1 of each claim. The limitation is interpreted as reading, "computer-readable medium embodying instructions ...".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 2-3, 5-6, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Shaw** (USPN 6,381,741).

Claim 2

Shaw disclosed a method for configuration management for a computing device *(Abstract)*, comprising:

- providing available software to be loaded into said computing device to said computing device through an interface *(Figure 1, elements 50 and 70; column 2, lines 58-67; column 1, line 65 to column 2, line 10)*;
- determining whether or not resident software stored in a storage device associated with said computing device is authenticated *(column 3, lines 40-65; Figure 2)*;
- determining whether or not said available software is authenticated *(column 4, line 6 to column 7, line 46)*;
- rejecting said available software if said resident software is authenticated and said available software is not authenticated *(column 3, line 66 to column 4, line 3; column 5, lines 34-41)*; and

- updating said resident software with said available software if one of the following three conditions is met:
  - (1) said resident software is authenticated and said available software is authenticated *(column 3, line 58-65; Figure 2; forced update)*.
  - (2) said resident software and said available software are not authenticated *(at least above condition 1 met)*,
  - (3) said resident software is not authenticated but said available software is authenticated *(at least above condition 1 met)*.

Claim 3

Shaw disclosed the method of claim 2 (as discussed above) wherein said determining whether or not said resident software is authenticated comprises:

- determining whether or not an authentication flag has been set *(column 3, lines 45-57)*;
- wherein said resident software is determined to be authenticated if said authentication flag has been set *(column 3, lines 48-50)*; otherwise
- said resident software is determined to be unauthenticated *(column 3, lines 48-50)*.

Claim 5

Shaw disclosed the method of claim 3 wherein said authentication flag is set by a service technician *(column 3, lines 55-65)*.

Claim 6

Shaw disclosed the method of claim 2 wherein said determining whether or not said resident software is authenticated comprises of performing a direct authentication procedure on said resident software *(column 3, line 66 to column 4, line 5)*.

Claims 22 and 24

The limitations of claims 22 and 24 correspond to claim 2 and as such are rejected in the same manner.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 4, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shaw** (USPN 6,381,741).

Claim 1

Shaw disclosed a method for configuration management for a computing device *(Abstract)*, comprising:

- providing available software to be loaded into said computing device to update a resident software within said computing device *(Figure 1, elements 50 and 70; column 2, lines 58-67; column 1, line 65 to column 2, line 10)*;
- determining whether or not resident software stored in a storage device associated with said computing device is authenticated *(column 3, lines 40-65; Figure 2)*;
- determining whether or not said available software is authenticated *(column 4, line 6 to column 7, line 46)*;
- updating said resident software with said available software if said resident software and said available software are ~~has~~ not ~~been~~ authenticated *(column 3, lines 45-58, system determines resident software corrupt and needs update; as shown above available software is also checked for authenticity)*;
- updating said resident software if said resident software is not authenticated but said available software is authenticated *(column 5, lines 34-41, no requirement to authenticate resident software here;*

further column 3, lines 45-58, sometimes update regardless of "TrustData" bit, for example if "RunDownloader" is set)

Shaw did not explicitly state setting an authentication flag if said resident software is not authenticated but said available software is authenticated. **Shaw** demonstrated that it was known at the time of invention to make use of flag indicators (column 3, lines 45-57; and column 4, line 45) and **Shaw** (as shown above) clearly demonstrates authenticating available code segments. It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of **Shaw** with a method of recording available code is authenticated (a flag) as found in **Shaw**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to make use of a common method/device (flag) of communicating/recording information (in this case is or isn't code authenticated). This action occurs regardless of whether resident software is or is not authenticated.

Claim 4

Shaw disclosed the method of claim 3 wherein said authentication flag is set when said available software is determined to be authenticated *(as above under claim 1).*

Claims 21 and 23

The limitations of claims 21 and 23 correspond to claim 1 and as such are rejected in the same manner.

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shaw** (USPN 6,381,741) in view of admitted prior art (herein referred to as **APA**).

Claims 7 and 8

Shaw disclosed the method of claim 6 (as discussed above). **Shaw** did not explicitly state: wherein said direct authentication procedure comprises performing a cyclic redundancy check; or wherein said direct authentication procedure comprises performing a secure hashing algorithm. **APA** demonstrated that it was known at the time of invention to utilize cyclic redundancy check, CRC (Specification, page 5, lines 24-35) and secure hashing algorithms, SHA (Specification, page 5, lines 24-35). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of **APA** into the system and method of **Shaw**. This implementation would have been obvious because one of ordinary skill in the art would be motivated to perform well-known authentication techniques to determine when an update was necessary in order to improve the performance of a computing system.

Response to Arguments

10. Applicant's arguments filed 28 December 2005 have been fully considered but they are not persuasive. Applicant argues: **Shaw** does not disclose: 1) determining authenticity for *available* software. This is demonstrated as previously indicated in column 5, lines 34-41, "a given segment of code is downloaded ... authenticated and validated. If the hash matches that in the table of updater then the ... code is authentic and is allowed to overwrite". This is read upon by the claim language, which makes no requirement of whether something is downloaded before or after it is authenticated. The claim language simply requires update which is demonstrated here by **Shaw**. These issues are believed to clarify all of Applicant's concerns and as such the claims remain rejected under the cited prior art.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 10:00am - 4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571)-272-3756. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained form either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see http://pair-direct.uspto.gov. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood
Patent Examiner
AU 2193
December 21, 2006

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